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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,686	11/16/2001	Lee Kirby Jameson	17,090B	2950

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EXAMINER

REICHLE, KARIN M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 1-11 and 24-25 are still withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 11.

### ***Specification***

2. It is noted that the amendment to page 7 filed 7-28-05 could not be entered since such paragraph does not match the text of the location set forth by Applicant.

### ***Drawings***

3. The petition to accept color photographs filed 11-27-01 has been placed in the application. It should be noted that such petition is decided by the SPE. Therefore, the application will be forwarded to the current SPE after mailing of this action for decision of the petition. It should be noted that the substitute drawings filed 4-15-02 includes only one set of the photographs.

### ***Claim Language Interpretation***

4. "Droplet" is interpreted in light of page 8, line 30-page 9, line 1 and claims 22-23, i.e. absent specific claiming thereof, no specific shape is required thereby. "Chemistries" is interpreted in light of page 8, lines 20-25. "Phase change liquid" is defined as set forth on page

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5, fourth full paragraph and page 7, first full paragraph. "Nonwoven" is defined as set forth on page 5, first full paragraph. "Personal care product" is defined as set forth on page 5, second full paragraph. "Topography of chemistry" is interpreted in light of page 8, lines 3-9. The term "hydrophobic" has not been specifically defined. The dictionary defines such as "antagonistic to, shedding, tending not to combine with or incapable of dissolving in water".

***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 12 and 14-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Webster '787. See Figures, i.e. the substrate is 3 and the droplets are 2. See also Claim Language Interpretation Section supra, and Webster at abstract (applies to claims 12, 14-21), paragraph bridging cols. 1- 2 (applies to claim 12, last two lines, claims 16-19), col. 3, lines 14-22 (applies to all the claims), col. 4, line 1-col. 5, line 14 (applies especially to lines 3-4 of claim 12, claims 14, and 22-23) and col. 7, lines 22-31 (applies to lines 3-4 of claim 12). For example, 5 to 400 nanoliters is equal to .005 to 4 cubed mm and a pyramid as set forth in col. 4, lines 56-61 and lines 44-46 when the projection is .1 mm would include a volume between .191 and .2 cubed mm., i.e. between 5 and 400 nanoliters. With regard to claims 22 and 23, in light of the amendments to claims 12 and 23, again 5 to 400 nanoliters is equal to .005 to 4 cubed mm and a hemisphere as set forth in col. 4, lines 40-41 and lines 44-46, i.e. when the projection, i.e. radius, is from .1 mm to 2.5 mm, includes a volume between between 5 and 400 nanoliters. With regard

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to claim 23 as now amended, see, e.g., col. 4, lines 1-16 again, e.g. the polymers listed include hydrophobic polymers, e.g., silicones.

7. Claims 12-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Di Luccio et al '129. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 12, 16, 22: see the Claim Language Interpretation Section supra, Figures, paragraph 52 and paragraph 51 of '129, i.e. the substrate is 40 and the droplets are 44. With regard to claim 13, see paragraph 32. With regard to claims 14-15, see paragraphs 43-45. With regard to claims 20-21, see paragraph 24. With regard to claim 23 and claim 12 as now amended, see claim 14 of '129 and paragraphs 39-42, which teach hydrophobic compositions of the droplets, e.g. oils, lipids. With regard to claims 17-19, these claims recite properties, functions and capabilities of the claimed structure. Since the Di Luccio et al reference teaches the same structure, there is sufficient factual evidence for one to conclude that such properties, functions and capabilities of the claimed structure are also inherent in the same structure of Di Luccio, see MPEP 2112.01

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 12-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-22, 45-46 and 52-53 of copending Application No. 09/990,697 (2002/0087129). Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed after the effective filing date of the '697 application, the one way *In re Vogel* test applies, i.e. are the claims of the instant application obvious in view of the claims of the '697 application? The answer is yes. With regard to claims 12, 14-16 and 20-22, see claims 14-22 of the '697 application as well as the definition of terms in paragraphs 18, 21, 24, 36-42 of '129, especially the last sentence of paragraph 39 (and thereby, e.g., col. 13, line 56-col. 14, line 10 of '934 and col. 18, lines 10-30 of '890, i.e. phase change). Note also paragraph 52 and claim 16 of '129. Attention is also reinvited to the Claim Language Interpretation section *supra*. Therefore, the instant application with regard to the enumerated claims is both 1) broader than the '697 claims and due to the language added by the 7-28-05 amendment also narrower than the '697 claims. With regard to 1), once an applicant has received a patent for a species on a more specific embodiment which would be the case if '697 issued, he/she is not entitled to a patent for

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the generic or broader invention. This is because the more specific anticipates the broader. See *In re Goodman*, supra. With regard to 2) see discussion of claim 23 infra. With regard to claim 13, the instant application claims more specific types of substrates than merely the porous substrate claimed in claims 14-22 of '697. However, porous materials of film, woven, nonwoven, paper and laminates or combinations thereof are well known in the absorbent article art for forming topsheets. Therefore, to employ such types of porous materials as the topsheet in the claims of '697 would be obvious to one of ordinary skill in the art in view of the recognition that such materials are porous and the desire of a topsheet of porous material by the '697 claims. In regard to claims 17-19, such claims recite properties, functions or capabilities of the claimed structure. The '697 claims include the structure claimed and disclosed as providing such properties, functions and capabilities in the instant application, e.g. semicircular cross section, medicament compositions including lotions and waxes, discrete segments of the disclosed and claimed height. Therefore there is sufficient factual basis for one to conclude that the properties, function and capabilities of the claimed structure would also necessarily and inevitably flow from the same structure of the '697 claims. With regard to claim 23, the claim recites a more narrow range of volume than that of the '697 claims. However, where the general conditions of a claim are disclosed in the prior art, e.g. skin health benefits and the general range in the '697 claims, it is not inventive to discover the optimum or workable ranges by routine experimentation, see *In re Allen et al*, 105 USPQ 233. With regard to the hydrophobic limitation added to claim 23, see the portions of '697 cited supra, i.e. medicament compositions including, e.g., emulsions, lipids.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Common Ownership***

10. Claims 12-23 are directed to an invention not patentably distinct from claims 14-22, 45-46 and 52-53 of commonly assigned 09/990,697 ('129). Specifically, see discussion in double patenting rejections supra.

11. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned '697, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

### ***Response to Arguments***

12. Applicant's remarks of 4-8-04 and 7-28-05 have been considered but are either deemed moot in that the issue discussed has not been reraised or deemed not persuasive for the reasons set forth supra. Specifically with regard to Webster, Applicant has not set forth what



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specific claim limitation is not taught by the portions cited by the Examiner supra as teaching the limitations. With regard to '697, Applicant's remarks are deemed narrower than the effective filing date of the reference which claims the benefit of a provisional application under 119(e). The statement of common ownership is also insufficient for the reasons set forth in the last Office communication of 5-26-05.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

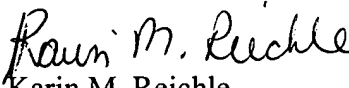
Any new grounds of rejection were necessitated by the amendments to claims 12-23 in this application and the claims added to '697.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Karin M. Reichle  
Primary Examiner  
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KMR  
October 12, 2005